

REMARKS/ARGUMENTS

Drawings

The Applicant notes the Examining Attorney has accepted the drawings as filed on February 9, 2004, and Applicant appreciates the same.

Anticipation - Section 102(b) Rejection

The Examining Attorney has rejected claims 1, 2, 6-9, 19-22, and 24 as being anticipated by Yentis (2,098,735). The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the arguments set forth below.

First of all, the applicant has amended independent claims 1 and 19, to include the limitation that the framework is configured for insertion into a cavity of one of a garment, boot and shoe, which may be in an upright position. The Yentis reference clearly does not include this limitation and is not capable of performing this function, and for at least this reason, there is no anticipation.

There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

The Yentis reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Obviousness - Section 103(a) Rejection

The Examiner has first rejected claims 10 and 11 as being unpatentable over Yentis alone. Since claims 10 and 11 are dependant on claim 1, and there is no anticipation of claim 1, not all of the elements of claims 10 and 11 are present upon which to base an obviousness rejection. Applicant therefore respectively requests the Examiner reconsider the rejection because not all the elements are present.

The Examiner has rejected claims 3-5, 12-14, 18 and 23 as being unpatentable over Yentis in view of Sloan '642. Since claims 3-5 are dependant on claim 1, and there is no anticipation of claim 1, not all of the elements of claims 3-5 are present upon which to base an obviousness rejection.

With respect to claim 12, it is not clear which elements from Sloan the Examiner is claiming are obvious to combine, or what the motivation to combine is.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-

obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO “failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Furthermore, it does not appear that the dryer and blower configuration of Sloan could even be combined with Yentis physically or mechanically, they are

simply two very different configurations and one would interfere with the other. There is therefore no motivation and no meaningful ability to combine the two, and therefore claims 3-5, 12-14, 18 and 23 are allowable.

The Examiner has further rejected claims 15-17 as obvious over Yentis in view of Sloan (5,289,642) and in further view of Swanson et al. (2001/0039991). These claims are dependent upon claim 12, and for the reasons stated above with respect to combining the non-combinable elements of Yentis and Sloan, the additional combination with Swanson is also therefore not a valid or obvious combination. does not include all elements required in claims 15-17.

Furthermore, there is nothing in the Yentis, Sloan and Swanson et al. references which suggests the desirability of the combination, or the motivation to combine the references, and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

Prior Art Made of Record and Not Relied Upon


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1-24 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 5-16-05

By: 
Mark W. Hendricksen
Reg. No. 32,356